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09/933,325	08/20/2001	Thomas L. Vance	210256	7052

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EXAMINER
ADDIE, RAYMOND W

ART UNIT	PAPER NUMBER
3671	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/933,325	Applicant(s) VANCE ET AL.
	Examiner Raymond W. Addie	Art Unit 3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 March 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. Claims 1, 9 are objected to because of the following informalities:

Both Claims 1, 9 end with double periods "screeded..".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification recites "the extension performing final grading and the concrete is poured into the ditch, such that the back edge of the open bottom 26 performs the screeding operation, while the skid 44 finishes the concrete surface, as cited on page 8.

The claims are in direct contradiction with respect to structural arrangement and to how the invention is operated. The claims provide that the extension screeds the concrete. However, as cited above, the extension is positioned in front of the open hopper and could not possibly screed the concrete, which is deposited in the ditch after the extension provides a final grading to the sub-base of the ditch.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17, last line, it appears as though at least one phrase is missing from the text of the claim, since the amendment to the claim introduced a "wherein statement" with no period "." ending the claim. Hence, the scope of the newly added limitation is indefinite.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4, 5, 8, 9, 10, 12, 13, 16-18, 20, 21, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stilwell # 4,217,065 in view of Fuller 2,551,110.

Stillwell discloses a slip-form ditch forming apparatus comprising:

A hopper (18) having a front and rear ends, joined by a pair of side walls. Said hopper further having an inner surface, outer surface, an open top and bottom, wherein said top has a larger opening than said bottom opening.

A first frame member (14) attached to the front end of the hopper.

A pair of front wheels (27) attached to said 1st frame member (14).

A 2nd frame member (16) attached to the rear end of the hopper (18).

A 2nd pair of wheels (27) attached to said 2nd frame member (16).

An extension (144) extending downwardly from the open bottom, proximate the front end, said extension having a flat bottom surface.

A skid (49) attached to the rear end of said hopper (at 59). Said skid having a shape or size consistent with the desired cross sectional configuration of a curb, a gutter or combination curb-gutter.

What Stilwell does not disclose is the specific shape to form a 3-sided ditch or gutter.

However, Fuller teaches a portable form for lining irrigation ditches comprising:

A hopper (8) having at least one baffle plate (23/24, 27/28). An extension (6) having a flat bottom surface (14) interconnecting a pair of outwardly slanting sides (4). A skid attached to a rear end (12) of said hopper (8) said skid having a pair of sloped sides (34) joined by a flat bottom surface (33).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the curb-gutter forming apparatus of Stilwell, with a 3-sided, gutter forming assembly, at taught by Fuller, in order to form gutter and ditches of a specific shape, as reasonably suggested by Stilwell. See Stilwell col. 4, lines 5-29, Col. 5, lines 25-56.col. 7, lines 29-col. 8, line 14; Figs. 1, 2, 4, 10. See Fuller col. 2-3 line 58; figs. 1-5.

In regards to Claims 2, 10 Stilwell discloses providing a tongue (114), attached to said 1st frame member (14). Said tongue being adapted to be attached to a locomotion device (104/117), such as a hand powered winch. Fuller teaches it is desirable to provide a tongue (31) having a plurality of vertically oriented tow points (32), for attaching to a locomotion device, such as a tractor. See Stilwell col. 7, line 47-col. 8, line 10. Fuller col. 3, lines 17-28.

In regards to Claims 4, 5, 12, 13 Stilwell discloses the open top of said hopper is larger than the open bottom and the hopper has an upper section that is wider than a corresponding lower section. See Fig. 2.

In regards to Claims 8, 16 Stilwell discloses essentially all that is claimed, except for the use of baffles. However, Fuller teaches it is desirable to provide a hopper with at least one baffle plate (23/24, 27/28) in order to control the volumetric throughput of the hopper. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the curb-gutter forming apparatus of Stilwell, with at least one baffle plate, as taught by Fuller, in order to control the amount of material being delivered to the slip-form. See Fuller Col. 2, lines 15-25.

5. Claims 3, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stilwell in view of Fuller as applied to claims 1, 9 above, and further in view of Gebhard # 2,598,903.

Stilwell in view of Fuller discloses essentially all that is claimed, to include the use of support wheels mounted to the lower end of the frame members. What Stilwell in view of Fuller does not disclose is the use of a plurality of stanchions. However, Gebhard teaches it is desirable to mount a canal lining machine (10) with a plurality of vertically adjustable stanchions (18) each supported on a corresponding wheel assembly (14, 15, 16, 17). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the gutter forming apparatus of Stilwell in view of Fuller, with a plurality of vertically adjustable stanchions, as taught by Gebhard, in order to control the thickness and pitch of the ditch lining formed by compacting the hopper contents against the sides of said ditch. See Gebhard col. 2, line 26-44.

6. Claims 6, 7, 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stilwell in view of Fuller, as applied to claim 1 above, and further in view of Brown # 4,379,653.

Stilwell in view of Fuller discloses essentially all that is claimed, to include the use of a forward extension disposed in front and below a hopper, for forming a surface to receive a material dispensed by said hopper. What Stilwell in view of Fuller do not disclose is the use of a brace and a chain.

However, Brown teaches it is desirable to provide a vertically adjustable slip-form, in the form of a front mounted edger plate (104), in order to smooth a surface in advance of receiving a material dispensed by said hopper. Said edger plate (104) being supported by a plurality of chains (108, 109), that are further supported by a cross brace (103) extending between a front end and a rear end of a distribution hopper, having an auger disposed therein and defined by said edger plates (66, 67, 68).

Therefore, it would have been obvious to one of ordinary skill to provide the curb-gutter forming apparatus of Stilwell in view of Fuller, with a vertically adjustable extension, such as an edger plate, as taught by Brown, in order to smooth a surface and define the thickness of a material about to be applied to said surface.

See Brown Col. 5, lines 37-48, col. 7, lines 25-55.

In regards to Claim 17 Stilwell discloses a method of forming a ditch comprising the steps of:

Placing a pair of coextensive forms (41a, 41b) on the ground.

Providing a ditch forming apparatus having a hoper with front and rear ends, side members, inner and outer surfaces. Said apparatus further having 1st and 2nd frame members attached to front and rear ends of said hopper, 1st and 2nd sets of wheels also attached, respectively, to said 1st and 2nd frame members; an extension extending downwardly from the open bottom proximate the front end; a skid attached to the rear end.

Said skid having a shape or size consistent with the desired cross sectional configuration of a curb, a gutter or combination curb-gutter.

Placing concrete into the hopper.

Pulling the ditch forming apparatus along the pair of forms.

What Stilwell does not disclose is providing an extension and screed sized and shaped to form a 3-sided ditch or gutter. However, Fuller teaches a method of lining ditches and gutter with a concrete material comprising the steps of: Providing a ditch forming apparatus having a hopper, at least one hopper baffle, an extension (6) having a flat bottom surface interconnecting 2 outwardly diagonal surfaces for shaping and smoothing a 3-sided ditch, a skid having a flat bottom surface interconnecting 2 outwardly diagonal surfaces for compacting and finishing a concrete layer that has been applied to a 3-sided ditch. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the method of forming a ditch of Stilwell, with the method of providing a 3-sided slip-form assembly, as taught by Fuller, in order to form a ditch lining in a desired shape and thickness, as reasonably suggested by Stilwell. See Stilwell col. 9, lines 30-46. Fuller col. 3, lines 17-53.

In regards to Claim 18 Stilwell and Fuller both disclose the method step of pulling the ditch forming machine via a tongue attached to the 1st frame member.

In regards to Claims 20-21 Stilwell discloses the method step of: Providing a hopper with a top opening that is larger than a bottom opening and Providing a hopper that has an upper section that is wider than a lower section.

In regards to Claim 24 Stilwell discloses essentially all that is claimed, except for the method step of providing a hopper baffle. However, Fuller teaches it is desirable to provide a ditch forming machine with a hopper having a baffle. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the ditch forming machine of Stilwell with a hopper baffle, as taught by Fuller, in order to control the volumetric throughput of the hopper contents.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stilwell in view of Fuller, as applied to claim 17 above, and further in view of Gebhard. Stilwell in view of Fuller discloses essentially all that is claimed, to include the use of support wheels mounted to the lower end of the frame members. What Stilwell in view of Fuller does not disclose is the use of a plurality of stanchions. However, Gebhard teaches it is desirable to support a canal lining machine (10) with a plurality of vertically adjustable stanchions (18) each supported on a corresponding wheel assembly (14, 15, 16, 17). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the method of forming ditches of Stilwell in view

of Fuller, with the method step of providing plurality of vertically adjustable stanchions, as taught by Gebhard, in order to control the thickness and pitch of the ditch lining formed by compacting the hopper contents against the sides of said ditch. See Gebhard col. 2, line 26-44.

8. Claims 22, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stilwell in view of Fuller, as applied to claim 17 above, and further in view of Brown. Stilwell in view of Fuller discloses essentially all that is claimed, to include the use of a forward extension disposed in front and below a hopper, for forming a surface to receive a material dispensed by said hopper. What Stilwell in view of Fuller do not disclose is the use of a brace and a chain. However, Brown teaches it is desirable to provide a vertically adjustable slip-form, in the form of a front mounted edger plate (104), in order to smooth a surface in advance of receiving a material dispensed by said hopper. Said edger plate (104) being supported by a plurality of chains (108, 109), that are further supported by a cross brace (103) extending between a front end and a rear end of a distribution hopper, having an auger disposed therein and defined by said edger plates (66, 67, 68). Therefore, it would have been obvious to one of ordinary skill to provide the curb-gutter forming apparatus of Stilwell in view of Fuller, with a vertically adjustable extension, such as an edger plate, as taught by Brown, in order to smooth a surface and define the thickness of a material about to be applied to said surface. See Brown Col. 5, lines 37-48, col. 7, lines 25-55.

Response to Arguments

9. Applicant's arguments, see paper 5, filed 3/5/2003, with respect to the 35 U.S.C. 112 2nd paragraph rejection of claims 19-24 have been fully considered and are persuasive. The 112 2nd paragraph rejection of claims 19-24 has been withdrawn.

Applicant's arguments filed 3/5/2003, with respect to the 103(a) rejections of the Last Office Action have been fully considered but they are not persuasive.
Applicant argues "their invention, as now claimed, is novel and non-obvious in light of the prior art".

However, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

The Applicant further argues "Applicant's devices uses an extension to screed concrete delivered from the hopper and a skip to help slip form the concrete so screeded".

The Examiner does not concur.
As cited on page 8, lns. 1-5 of the instant application, the invention is disclosed to "The extension 38 performs final grading and the concrete is poured into ditch...the back edge of the open bottom 26 performs the screeding operation while the skid 44 finishes the concrete surface".

Hence, Applicant's claim language and arguments contradict the disclosed invention, as cited in the specification. Therefore, the arguments are not persuasive.

The Applicant further argues the stanchions of the Applicants' device are different relative to the hydraulic stanchions found on the Gebhard device, which stanchions are intended to raise and lower the Gebhard device with respect to the ditch, wherein the device may be found during the forming operation, whereas the Applicants' device, by having stanchions that are spaced apart from the wheels, are designed to provide support for the device when the device is not on its wheels".
However, In response to applicant's argument that "There exists no motivation or suggestion to combine the wheel based stanchions of the Gebhard device with combined teaching of Stillwell and Fuller"; the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Finally, the Applicant argues "the H-shaped baffles of Applicants' device are completely different relative to the plates found in the Fuller device, which plates are designed to prevent formation of pockets of cement in the corners of the hopper to insure the prompt feeding action of the concrete from the hopper to the vents".

However, In response to applicant's argument that "The plates of Fuller are designed to prompt concrete flow, whereas Applicants' baffles are designed to retard concrete flow and the two systems are quite different", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Addie whose telephone number is (703) 305-0135. The examiner can normally be reached on Monday-Friday from 8:00 am to 2:00 pm, 6-8 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (703) 308-3870. The fax phone number for this Group is (703) 305-8623.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Thomas B. Will
Supervisory Patent Examiner
Group 3600

RWA
4/10/2003